



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,961	01/14/2002	Svetlana A. Lyapina	CIT1510-3	4414

28213 7590 06/03/2003

GRAY CARY WARE & FREIDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

EXAMINER

WEBER, JON P

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/046,961	LYAPINA ET AL.
	Examiner	Art Unit
	Jon P Weber, Ph.D.	1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 11-47 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,7 and 9 is/are rejected.
- 7) Claim(s) 2-6,8 and 10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

<ol style="list-style-type: none"> 1)<input type="checkbox"/> Notice of References Cited (PTO-892) 2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u>. 	<ol style="list-style-type: none"> 4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6)<input type="checkbox"/> Other: _____.
--	--

Status of the Claims

Claims 1-47 have been presented for examination.

Election/Restrictions

Applicant's election of Group I, claims 1-10 in Paper No. 9, filed 31 March 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 11-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made effectively **without** traverse in Paper No. 9. It is suggested that the nonelected claims be canceled in response to this Office action to expedite prosecution.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code at page 10. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman et al. (1998) in view of Deshaies et al. (US 6,165,731).

Glickman et al. (1998) disclose that the Rpn11 subunit in the proteosome has deubiquitinating activity (paragraphs bridging pages 3158-3159). At Table 5 they provide a list of putative Rpn11 homologs based on the presence of the conserved Cys box catalytic grouping (page 3153-4) seen in many deubiquitinating proteins. The deubiquitinating activity of the proteosome preparation was tested with ubiquitin conjugates but the results (not presented) showed low activity. Rpn11 is disclosed instantly at page 7 to be a JAB subunit. Glickman et al. (1998) do not recite that ubiquitin is a modifier protein.

Deshaies et al. (US 6,165,731) disclose that ubiquitination is an important process in cell cycle regulation. That is modifying unstated proteins with ubiquitin regulates their activity.

A person of ordinary skill in the art at the time the invention was made would have been motivated to deconjugate ubiquitin from a target protein with Rpn11 of the proteosome disclosed by Glickman et al. (1998) because a person of ordinary skill in the art would reasonably expect that Rpn11 would remove (deconjugate) ubiquitin from an ubiquitin modified target protein involved in cell cycle regulation.

Hence, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to deconjugate ubiquitin with proteosome from a JAB-containing subunit like Rpn11.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

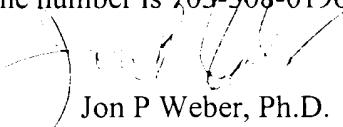
Claims 2-6, 8 are free of the prior art because the prior art does not teach or fairly suggest that the target protein contains cullins or has ubiquitin ligase activity, or that the modifier protein could be other than ubiquitin.

Claims 2-6, 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 703-308-4015. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jon P. Weber, Ph.D.
Primary Examiner
Art Unit 1651

JPW
May 30, 2003